

REMARKS

Claims 1-4, 6-7, 14-20, and 36-39 are pending. Claims 1-4, 6-7, 14-18, and 20 are amended and claims 5, 8-13, and 21-35. Applicant reserves the right to pursue the canceled subject matter in one or more continuation applications. Support for the amendment to claim 1 is found in original claim 13 and in the as-filed specification at page 9, line 20. The remaining claim amendments delete terms found in the original claims as-filed. No new matter is added.

Abstract

The abstract of the disclosure is objected to because the Examiner says that it has not been presented in the proper format. Applicant has amended the specification as described in MPEP 608.01(b). Applicant requests withdrawal of the rejection.

Claims alleged to be Improper

Claims 2-4 and 14-16 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should depend on other claims in the alternative only. Applicant respectfully disagrees. The claims referenced by the Examiner are not multiple dependent claims. Specifically, Applicant directs the Examiner to the pending claims as filed in the preliminary amendment filed on August 25, 2006. Claim 2 depends only on claim 1 and claims 3-6, 14-17, and 19-24 were amended such that they no longer are multiply dependent claims. Applicant requests withdrawal of the objection.

35 U.S.C. 112, second paragraph

Claims 1-24 and 32-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter with Applicant regards as the invention. The Examiner contends that it is not clear at what position the "N-oxide" (claim 1) of the claimed compound is located. Applicant respectfully disagrees. However, in an effort to expedite prosecution, the term "N-oxide" has been deleted from the claims. Applicant requests withdrawal of the rejection.

35 U.S.C. 112, first paragraph

(A) Claims 1-24 and 32-39 are rejected under 35 U.S.C. 112, first paragraph, because

the Examiner states that the specification, while being enabling for a pharmaceutically acceptable salt of the claimed compound, does not reasonably provide enablement for a prodrug of the claimed compound. Applicant respectfully disagrees. However, in an effort to expedite prosecution, the term “prodrug” has been amended from the claims. Applicant requests withdrawal of the rejection.

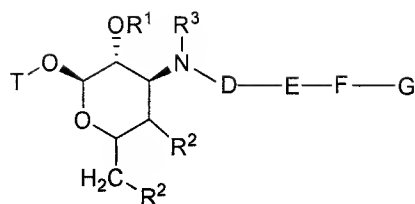
(B) Claims 20-24 and 32-39 are rejected under 35 U.S.C. 112, first paragraph. The Examiner states that the specification, while being enabling for therapeutic treatment of bacterial infections, does not reasonably provide enablement for prophylactic treatment or prevention or the treatment of any disease state (claim 20), the treatment of any microbial infection (claim 21), the treatment of any proliferating disease (claim 24), the treatment of a viral infection (claim 32), the treatment of an inflammatory disease (claim 33) or the method of treating a disease state caused by a nonsense or missense mutation (claim 35). Applicant respectfully disagrees. However, in an effort to expedite prosecution, the claims have been amended to recite “a method of treating a bacterial infection” –the disease which the Examiner states is enabled. Accordingly, Applicant requests withdrawal of the rejection.

35 U.S.C. 102

Claims 1-17, 19-24, and 32-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Or et al. (WO 99/16779)(referred to herein as “Or”). The Examiner states that Or discloses the claimed 3'-N-heterocyclic ring modified erythromycin derivatives useful for treating bacterial infections (pages 2-21) and that the claimed compounds and methods are anticipated by Or. Applicant respectfully disagrees.

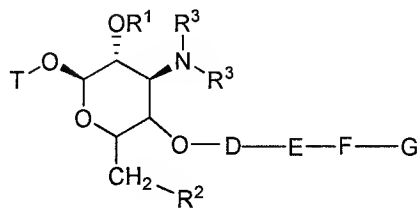
To anticipate a claim, the reference must teach every element of the claim. MPEP 2131. The identical invention must be shown in as complete detail as is contained in the ...claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

As amended, the present claims are directed to compounds having the formula:



I

or



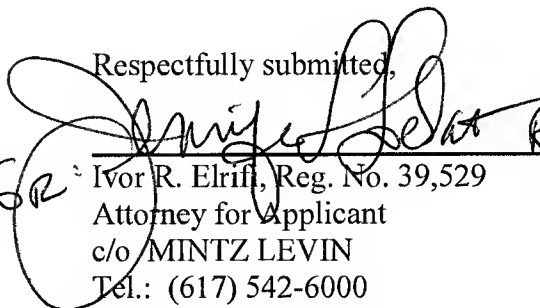
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or a pharmaceutically acceptable salt, or ester thereof, wherein D is a C₁₋₆ alkyl group, E is an optionally substituted 1,2,3-triazoyl, and T is a 14-membered erythromycin derivative.

Applicants submit that Or does not teach the claimed invention. Specifically, Or does not disclose compounds, which contain a C₁₋₆ alkyl group attached to an optionally substituted 1,2,3-triazoyl moiety. Accordingly, the presently claimed compounds and methods are not anticipated by Or. Withdrawal of the rejection is requested.

CONCLUSION

On the basis of the foregoing amendment and remarks, Applicant respectfully submits that the pending claims are in condition for allowance. Should any questions or issues arise concerning this application, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,

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